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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,210	12/05/2001	Andrew M. Spencer	10014184-1	4151

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[REDACTED] EXAMINER

HESS, DANIEL A

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2876

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/002,210	SPENCER, ANDREW M.
Examiner	Art Unit	
Daniel A Hess	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_ .
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, in claim 1, the applicant uses the term 'high data transfer rate.' What defines a high data transfer rate is not clear.

Appropriate clarification and correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (US 6,377,218).

Re claims 1 and 5: Nelson shows a device, namely a PCMCIA card, having a wireless transmission means and a wireline connector (column 1, lines 5-12). Figure 2 shows the

different modes of communicating: there is a contact means 240 and a contact-less means 210 (column 4, line 35-column 5, line 4).

Nelson fails to show that the PCMCIA card has a memory mass storage.

However, it is known that a PCMCIA card can be a memory card. The 'M' in PCMCIA stands for 'memory' and while the standard has grown to include other types of cards, cards having memory mass storage. Webopedia.com describes 'PCMCIA': "Short for *Personal Computer Memory Card International Association*, and pronounced as separate letters, PCMCIA is an organization consisting of some 500 companies that has developed a standard for small, credit card-sized devices, called PC Cards. Originally designed for adding memory to portable computers, the PCMCIA standard has been expanded several times and is now suitable for many types of devices."

In view of Nelson's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known memory mass storage as taught because this can add memory to portable computers, allowing a greater variety of more powerful applications to be run.

Re claim 2: As shown in figure 2, both the contact-based means and the contactless means employ the same controller 230. Since this is the case (as opposed to a dual controller system) there must be a method of switching between the contact-less means and the contact-means, i.e. selecting a data chunk from one or the other. This is analogous to a single processor computer system where things happen in serial and many functions must get in line while the processor handles them one by one and switches between them.

Re claims 3 and 4: As is shown in figure 2, the wired-mode and the wireless mode represent two distinct channels for communication, and could involving communication with two separate systems, one for each channel. Thus if a computer attempts to communicate with the

card via contact means, the reply would be via the same channel. Why? Because the wireless means on the card may not even be in communication with the computer, but some other device, such as a LAN or the Internet (see figure 1, item 125) or with a peripheral device (see figure 1, item 135). Similarly, an attempt to communicate with the card wirelessly would result in an in-kind response.

Re claims 6-8: The card must have a way of receiving signals, and that way of receiving signals amounts to monitoring. As discussed re claims 3 and 4 above, the wired-mode and the wireless mode systems may operate different channels of communication. Thus it is implied that a wireless signal to the card draws a wireless response from the card. If the card is operating using the contact means and then (for example on a wireless LAN) a contactless communication comes in, it must respond in kind, thus switching to the wireless mode. Note the discussion re claim 2 above regarding the need to switch.

Re claim 9: The card may act as a connection means to a wireless network (column 4, lines 45-50). In order to be online on a wireless network, the card must first login or connect to the network. This can happen automatically or manually through a user selection; however making the process automatic is not alone grounds for patentability.

In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an

automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Nelson fails to show that the monitoring and switching occurs at start-up.

The examiner takes Official Notice that desktop computers he has used automatically connect to the local network on startup, prior to the invention by the applicant.

In view of old and well-known LAN technology, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known automatic connection to the network at startup into the teachings of Nelson because this permits instant access to network functionality without the need to wait for a connection to take place.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wallace et al. (US 6,295,031) Sanad (US 5,657,028), Nelson et al. (US 6,404,393) and Henrie et al. (US 6,219,732) each show a card having multiple communication means.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DH

October 29, 2002

Daniel A Hess  
Examiner  
Art Unit 2876



KARL D. FRECH  
PRIMARY EXAMINER